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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,222	07/19/2002	Egbert Muller	MERCK 2403	2488
23599	7590	12/19/2003	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.			THERKORN, ERNEST G	
2200 CLARENDON BLVD.			ART UNIT	
SUITE 1400			PAPER NUMBER	
ARLINGTON, VA 22201			1723	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/089,222

Applicant(s)

MULLER ET AL

Examiner

Ernest G. Therkorn

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1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(B) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lang (U.S. Patent No. 3,222,444). The claim is considered to read on Lang (U.S. Patent No. 3,222,444). However, if a difference exists between the claim and Lang (U.S. Patent No. 3,222,444), it would reside in optimizing the steps of Lang (U.S. Patent No. 3,222,444). It would have been obvious to optimize the steps in Lang (U.S. Patent No. 3,222,444) to enhance separation.

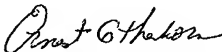
Claims 1-4 and 12-13 are rejected under 35 U.S.C. 102(B) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fiebush (EP 366,252). The claims are considered to read on Fiebush (EP 366,252). However, if a difference exists between the claims and Fiebush (EP 366,252), it would reside in optimizing the steps of Fiebush (EP 366,252). It would have been obvious to optimize the steps in Fiebush (EP 366,252) to enhance separation.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiebush (EP 366,252) as applied to claims 1-4 and 12-13 above, and further in view of Nakaniski (WO 95/03256). At best, the claims differ from Fiebush (EP 366,252) in reciting use of a column shaped moulding, a flat moulding, or mesopores and macropores of a particular diameter. Nakaniski (WO 95/03256) (page 2, lines 19-21 and page 4, lines 5-9) discloses use of a column shaped moulding overcomes the high flow resistance of beads. Nakaniski (WO 95/03256) (page 10, lines 19-21) discloses use of a flat sheet allows a moulding to be used for thin layer chromatography. Nakaniski (WO 95/03256) (page 4, lines 20-24) (page 4, lines 17-24 and page 10, lines 32-page 12, line 4) discloses the mesopores and macropores of the recited diameter provide a good balance between strength and chromatographic properties. It would have been obvious to use a column shaped moulding in Fiebush (EP 366,252) because Nakaniski (WO 95/03256) (page 2, lines 19-21 and page 4, lines 5-9) discloses use of a column shaped moulding overcomes the high flow resistance of beads. It would have been obvious to use a flat moulding in Fiebush (EP 366,252) because Nakaniski (WO 95/03256) (page 10, lines 19-21) discloses use of a flat sheet allows a moulding to be used for thin layer chromatography. It would have been obvious to use a flat moulding in Fiebush (EP 366,252) because the mesopores and macropores of the recited diameter because Nakaniski (WO 95/03256) (page 4, lines 20-24) (page 4, lines 17-24 and page 10, lines 32-page 12, line 4) discloses the mesopores and macropores of the recited diameter provide a good balance between strength and chromatographic properties.

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The remarks urge that the restriction is improper because claim 1 is patentable over Lang (U.S. Patent No. 3,222,444). However, claim 1 is considered to be either anticipated or obvious over Lang (U.S. Patent No. 3,222,444). In any event, claim 1 is either anticipated or obvious over Fiebush (EP 366,252). As such, the special technical feature linking the inventions does not provide a contribution over the prior art and no single inventive concept exists. Accordingly, the restriction has been reconsidered, deemed proper, and made final for the reasons of record.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (571) 272-1149.

  
**Ernest G. Therkorn**  
**Primary Examiner**  
**Art Unit 1723**

EGT  
December 15, 2003